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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,941	04/05/2004	Nicholas Healey	P67148US1	2300
136	7590	01/12/2006	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			DINH, DUC Q	
			ART UNIT	PAPER NUMBER
			2674	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/816,941	Applicant(s) HEALEY, NICHOLAS	
	Examiner DUC Q. DINH	Art Unit 2674	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 28, 2005 has been entered.

Specification

2. Claims 46 and 51 objected to because of the following informalities:

Limitation "control member" in line 9 of claims 46 and line 6 of claim 50 should read, "control platform" for being consistent with the amended limitation "an upwardly-facing control platform".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21-29, 35-45, 46-47, 49-54 are rejected under 35 U.S.C. 102(b) as being anticipate by Derocher et al. (U.S Patent No 5,914,702), hereinafter Derocher.

In reference to claim 21, Derocher discloses a pointing device in Figs 4-6 for a computer comprising:

Art Unit: 2674

a fixed mounting (74);

a transducer means for generating a vector output signal in response to x and y components of force transmitted thereto (col. 6, lines 42-44);

an upwardly facing control platform (cover plate 72; Fig. 4) engaged by an upon in the x and y directions by at least two spaced apart fingers tips of one hand of a user (col. 6, lines 24-25) and said control platform being mounted for limit travel in the x and y directions on said fixed mounting, said control platform being coupled to the transducer (sensor) for transmitting said components of force thereto (col. 6, lines 40-45);

said control device having a profile which is sufficiently low to enable it to be accommodated in the thickness of a base portion of a clamshell design laptop computer (see Fig. 1; col. 5, lines 45-55).

In reference to claims 22 and 23, Derocher discloses the control platform (cover plate 72) has a substantially horizontal/upright fingertip engaging controls surface (col. 6, lines 24-28).

In reference to claim 24, Derocher discloses the control platform is disposed in a well (Fig. 4) said well having a upper right inner surface and said control platform having a peripheral outer surface facing inner surface and spaced apart therefrom to defined a gap between the inner surface and said outer surface (Fig. 4; col. 5, lines 56-65).

In reference to claims 26-28, Fig. 1 shows a horizontal wrist rest surface for the control device on a laptop computer and the cover plate 72 flush with that wrist rest surface

In reference to claim 29, Fig. 1 shows the control platform (72) has an upper surface recessed with respect to said wrist rest surface as claimed.

Art Unit: 2674

In reference to claim 35, Fig. 4 shows the gap between the cover plate 72 and the frame of the lower body containing the post 74 for substantially preventing movement of the control platform in x and y directions

In reference to claim 36, Derocher discloses the control member (72) is mounted on a pivot mounting (74) for enabling rotation of said control platform in the x-y plane by the user (col. 6, lines 36-39).

In reference to claim 37, Derocher discloses a keyboard (18) incorporating a control device in Fig. 1.

In reference to claim 38, Derocher discloses the computer having a display and cursor control circuitry for displaying a cursor on said display, an output of said control device being coupled to said cursor control circuitry for controlling the movement of said cursor (col. 26-35; Fig. 1).

In reference to claim 39, Derocher discloses a laptop computer having a keyboard and a wrist-rest area disposed adjacent to said keyboard (18) and wherein said control device (20) is located in said wrist-rest area (Fig. 1).

In reference to claim 40, Derocher discloses a laptop computer (Fig. 1) having a wrist-rest surface and a pointing device (20) located adjacent to said wrist-rest surface, said pointing device comprising:

a fixed mounting (74) below said wrist-rest surface;

transducer (sensor) means for generating a vector output signal in response to x and y components of force transmitted thereto; and

an upwardly-facing control platform engaged (72) acted upon in the x and y directions by a least two spaced-apart fingertips of one hand of a user and mounted for limited travel in the x and y directions on said fixed mounting, said control platform being coupled to said transducer means for transmitting said x and y components of force thereto (see the rejection as applied to claim 1).

In reference to claim 41, Derocher discloses the platform (72) which has at least one fingertip-operable switch means carried in a peripheral region of said control member for generating a switching signal distinct from said vector output signal (col. 6, lines 25-35).

In reference to claim 42, Derocher discloses the sensor includes two transducers for sensing respective orthogonal x and y force components and generating vector output signal components (col. 6, lines 41-46).

In reference to claim 43, refer to the rejection as applied to claim 24. In addition, Derocher discloses a recess is formed in said wrist-rest surface and said control member (72) is disposed in said recess, said recess having an upright inner surface and said control member having a peripheral outer surface facing said inner surface and spaced apart therefrom to define a gap between said inner surface and said peripheral outer surface (see Figs. 1 and 4-6).

In reference to claim 44, Derocher discloses the fingertip switch means 26 is coupled to the platform for generating a switching signal distinct from said vector output signal (col. 3, lines 46-54).

In reference to claim 46, Derocher discloses a low-profile control device for a computer, the control device comprising:

a fixed mounting (74);

Art Unit: 2674

transducer means for generating a vector output signal in response to x and y components of force transmitted thereto (col. 6, lines 41-46)

an upwardly-facing control platform engaged by and acted upon in the x and y directions by at least two spaced apart fingertips of one hand of a user and mounted on said fixed mounting for limited travel, imperceptible to the user in the x and y directions, said control member being coupled to said transducer means for transmitting said components of force thereto (see the rejection as applied to claim 40).

In reference to claim 47, Derocher discloses the control device said control member is substantially oval in plan view (Fig. 5).

In reference to claim 49 the control device comprising a wrist-rest surface as shown in Fig. 1.

Claims 50-54 are method claims corresponding to the apparatus of claims 40-44 and 46-48 and therefore, rejected based on the same basis set forth in said claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 30-34, 45 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Derocher (U.S. Patent No 5,914,702).

In reference to claims 30-31, 45 and 48, Derocher does not disclose the dimension of the control member as claimed; however, it would be obvious to one of ordinary skill in the art

Art Unit: 2674

to change the dimension of the control member as desired as was judicially recognized with IN Rose 105 USPQ 237,(CCPA 1955), which recognizes that change the size of well known element is normally not desired toward patentable subject matter.

In reference to claims 32-34, Derocher does not disclose that the restricting member (the space between the cover plate 73 and the frame containing the fixed mounting post 74) in at least 50mm or less or 30mm or less or 10 mm or less. It would have been obvious for one of ordinary skill in the art at the time of the invention was made adjust the space the space between the cover plate 73 and the frame containing the fixed mounting post 74 to restrict travel of the control member as user desired as was judicially recognized with IN Rose 105 USPQ 237,(CCPA 1955), which recognizes that change the size/range of well known element is normally not desired toward patentable subject matter.

Response to Arguments

7. Applicant's arguments with respect to claims 1-54 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DUC Q DINH whose telephone number is (571) 272-7686. The examiner can normally be reached on Mon-Fri from 8:00.AM-4:00.PM.

Art Unit: 2674

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edouard Patrick can be reached on (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DUC Q DINH
Examiner
Art Unit 2674

DQD
January 8, 2006



PATRICK N. EDOUARD
SUPERVISORY PATENT EXAMINER